

Serial No. 10/511,022
Atty. Doc. No. 2002P06124WOUS

REMARKS

Claims 4, 9, 10, and 12 are pending in the application. Claims 4, 9, 10, and 12 are rejected under 35 USC 103(a) as being unpatentable over Applicant's Admitted Prior Art [hereinafter AAPA] in view of Becker (US 6,233,509), Nishikawa et al. (US 6,587,901), and Price et al. (US 5,920,197). No amendments are made herein. Claims 4, 9, 10, and 12 are presented for examination.

Response to rejections under 35 USC 103(a)

On page 4, lines 18-22 of the office action, the Examiner concedes that AAPA as modified by Becker lacks a presence detection circuit as claimed. In the office action on page 5 lines 18-22, Examiner motivates the addition of Nishikawa to the combination "for the advantage of providing unnecessary of delivering a signal controlling said coupling unit (i.e., bus connection means) from device on said field bus device (i.e., information processing apparatus) to said mobile data unit (i.e., portable electronic equipment), enabling a reduction in the number of data link lines (i.e., transmission lines; See Nishikawa, col. 3, lines 24-28)." However, this proposed motivation does not apply to the Examiner's proposed combination, because it requires a different embodiment of Nishikawa. Furthermore, it only applies to a combination that does not produce Applicant's invention. In addition, it contradicts other grounds of rejection in the present office action. Following are supporting arguments:

1) Nishikawa col. 3, lines 24-28 are relied upon by the Examiner for the above motivation, but these lines refer to a different embodiment of Nishikawa than the one used by the Examiner for the proposed combination. The Examiner proposes a combination with Nishikawa's embodiment of FIG 1. However, the cited lines refer to Nishikawa's embodiment of FIG 7, which has two independent presence detection circuits 130 and 210, one in the portable terminal 100 and one in the host information apparatus 200. It is the separate detection circuit 130 in the portable terminal of FIG 7 that makes presence signaling from the host apparatus to the portable terminal unnecessary. See Nishikawa col. 10, lines 34-47 ("FIG. 7 shows . . . unnecessary.").

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2) A combination with Nishikawa's embodiment of FIG 7, as motivated above, would not produce Applicant's invention as claimed, firstly because it would require a second presence detection circuit in Applicant's mobile BuB device, and secondly because Applicant's base claims 4 and 12 recite "the local controller can transmit a selection of views to the mobile data unit via the digital signal line", but Examiner's motivation for the combination is to eliminate such transmission in order to reduce the number of data link lines.

3) Examiner argues in the office action on page 5, lines 11-14, that the local controller (i.e. the CPU) can transmit a selection of views (i.e., configuration) to the mobile data unit via the digital signal line (i.e. line 213 of FIG 1). However, this is the very signal line and the very transmission that would be eliminated, based on Examiner's above motivation for the combination. See Nishikawa col. 10, lines 42-47 ("A point . . . unnecessary").

The above arguments apply to both of Applicant's independent claims 4 and 12, since Examiner's grounds and motivation are repeated for these two claims in the above respects.

Conclusion

Therefore, the proposed combination with Nishikawa's FIG 1 lacks motivation, and must be guided by Applicant's invention. However, if the combination with Nishikawa is made consistent with the above motivation, then it does not produce Applicant's invention as claimed. Accordingly the cited prior art does not support a 35 USC 103 rejection of the independent claims 4 or 12. These arguments extend to claims 9 and 10 as well, since they depend from claim 4.

For a claim to be obvious under 35 USC 103, any modification to known prior art must also be suggested by the prior art, not by the Applicant's invention; furthermore, such modification must work, and it must produce the Applicant's claimed invention. These criteria are not met by the cited prior art, as argued above. Therefore the Applicant believes this application to be in condition for allowance. Reconsideration and allowance are respectfully requested.


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Respectfully submitted,

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By: 
John P. Musone
Registration No. 44,961
(407) 736-6449

Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, New Jersey 08830